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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,354	06/30/2003	Kiyoshi Miyazaki	50596/DBP/A400	8169

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EXAMINER

LOCKER, HOWARD J

ART UNIT PAPER NUMBER

1661

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611354

Applicant(s)

Miyazaki, et al.

Examiner

Howard J. Locker

Group Art Unit

1661

--The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address--

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 6/30/03, 10/6/03 and 7/23/04.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ ~~Claim(s)~~ The claim is is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☒ ~~Claim(s)~~ The claim is is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☐ Claim(s) are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 10/06/03 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

1. The following is a quotation of section (a) of 37 CFR 1.163:

"(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered."

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor in carrying out his invention."

In plant applications filed under 36 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

"No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which applicant regards as his invention."

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

"The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted."

The disclosure is objected to under 37 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known varieties and antecedents.

A. At page 1 of the specification, the recitation "*Viola* is *Violaceae* plants" is not clear, as it is not understood why the family name appears in this regard. It would appear that such should be appropriately designated as the family name if it is maintained in the specification.

B. The species designation "*wittorockiana*" should be reviewed for accuracy and amended as necessary, as it appears that such should properly be "*wittrockiana*". Additionally, there appears to be something missing in the sentence appearing at lines 18-21 of page 1, and *V. wittorockiana* (sic), does not appear to be properly characterized as the garden pansy. Rather, such appears to be more properly descriptive of *V. cornuta*.

C. The specification as currently drafted contains a substantial amount of rough language, confusing language, and numerous typographic errors, due perhaps to translation from Japanese to English. It is requested that the specification be redrafted in such a manner as to present more proper and understandable sentence or sentence fragment structure, so as to more clearly and completely set forth the distinctive botanical features of the plant and also of the comparative and/or parental varieties (see for example “long oblong” at line 6 of page 3; “serrated or lobed” at line 9 of page 3; “Those of *Viola cornuta* plants” at line 15 of page 2; “Overall” at line 6 of page 3).

D. Foliage margin characteristics for *V. cornuta* should be more clearly set forth in the specification, as the recitation “deeply segmented” is less than illuminating.

E. The female parent is variously set forth as “9V-39a” and as “9A-39”.
Correction to a single designation in this regard is necessary.

F. The recitation “Omi R & D Center of Suntory Flowers Ltd., located at 863-1, Aza-Iketani, Omori-cho, Yokaichi-shi, Shiga-ken, Japan” (and associated recitations setting forth the specific place of business/nursery) should be amended so as to not set forth the specific place of business/nursery, as such is seen as constituting unwarranted and improper advertising.

G. The recitations “flower color – self-colored” and “petal color – Self-colored” as used repeatedly in the specification are not understood. Correction and/or clarification is necessary.

H. The recitation “petal number – single” does not appear accurate in that the bloom is stated to generally comprise 5 petals.

I. If the comparative cultivars ‘Violetto Nive’ or ‘Alpine Summer’ are themselves the subject of United States Plant Patents or to pending applications for same, such should be positively referenced in the specification.

J. The section of the specification dealing with botanical characteristics of the parental and comparative cultivars should be significantly shortened. Such could be properly shortened to the extent that the instant cultivar remains distinguished from each of same.

K. “Vertically oblonged” as appears at line 18 of page 11 does not read clearly or correctly.

L. If more substantive information is present relative to characteristic branching of the instant plant, such should be imported into the specification in the interest of providing as complete a botanical description of the plant as is reasonably possible.

M. The recitations at lines 9 and 10 of page 12 should be amended so as to be more meaningful. The present recitations state little or nothing in positive or meaningful terms.

N. Characteristic number of petals per bloom should be set forth in the specification, as should characteristic/observed lastingness of the individual bloom.

O. Characteristic time of flowering should be more substantively accounted for, such as by setting forth the observed times relative thereto in the stated location(s) of culture.

P. Characteristic petal/bloom coloration needs to be more clearly and meaningfully set forth, such as by reference to the employed color chart. The designations "self-colored" are not understood.

Q. The recitations "Cold – Strong", "Heat – Medium" should be more substantively accounted for, as these botanical features are important commercial characteristics of the plant.

R. Reproductive organs should be accounted for in the specification, at least to such degree as to account for the presence (or absence) of same and general characteristics thereof. If pollen is characteristically produced, such should likewise be accounted for in the specification.

Applicant should carefully review and address each of the above, and should review the instant disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

2. The claim is rejected under 35 U.S.C. 112, first and second paragraphs, as not being supported by a clear and complete botanical description of the plant, for the reasons advanced in paragraph 1 above.

3. Applicant is advised of the new mandatory procedures for amending the specification and claim under 37 CFR 1.121. Applicant may review same on the Internet at the following site:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

4. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patents must now be addressed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

For further information regarding the new address, see Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).


5. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 571-272-0980, and whose normal work hours are Monday through Thursday, from 6:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Andrew Wang, can be reached at 571-272-0811.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 1600 receptionist whose telephone number is 571-272-1600.

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to TC 1600 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The official fax number for TC 1600 is: 703-872-9306.


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661

Howard J. Locker/hjl

September 30, 2004